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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,404	09/12/2000	Ejler L. Sorensen	1137U101	6670

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CANADA

EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 12/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/660,404

Applicant(s)

SORENSEN, EJLER L.

Examiner

John R. Paradiso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 10-15 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 10-15 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 1 lines 8-11 recite:

“fastening means securing said first pair of clamp bars to said second pair of slide rods;
fastening means securing said second pair of clamp bars to said first pair of slide rods;”

Page 11 of the instant Specification recites “Right pull rods 66 and 68 are fastened as at right rod ends 82”. However, the claimed “fastening means” are not described.

Claim Rejections - 35 USC § 103

4. Claims 10-15 and 21-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over GOLDBERG ET AL.

5. GOLDBERG ET AL discloses a gripper apparatus with a gripper body member (26) and a first slide rod (44) and a second slide rod (46) supported on the gripper body member. A first clamp bar (12) is slidably connected to the first slide rod (44) and a second clamp bar (20) is slidably connected to the second slide rod (46). The first shaft goes through a bearing opening in the second clamp bar and, likewise, the second shaft goes through a bearing opening in the first clamp bar. Note that figure 1 of GOLDBERG ET AL does not show the label for (12), but it is clear from the disclosure in GOLDBERG ET AL that the “first clamp bar (12)” of GOLDBERG ET AL comprises first support bar (14) and first surface bar (16).

Fig. 1 of GOLDBERG ET AL shows the first and second shafts (44, 46) as connected to the frame by a press-fitted connection. The shafts of GOLDBERG ET AL are thereby fastened to the clamp bars by means of the frame.

A motor (42) provides a means for moving the slide rods in opposing directions (since the slide rods must be oppositely threaded to move the clamp bars apart and together) causes the first and second shaft to simultaneously move the clamp bars toward each other in a gripping position and away from each other in a releasing position.

Regarding claim 12, the slide rods are moved by a screw means in the form of a worm gear (integral to the slide rods; See GOLDBERG ET AL column 2 lines 26-32 and column 2 line 59 to column 3 line 3)

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6. GOLDBERG ET AL does not disclose a plurality of clamp bar pairs or a plurality of first/second slide rod pairs.

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for multiple shafts in order to increase the gripping power of the clamp bars, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

8. Examiner notes that the preambles to the each claim recites "Carton gripper apparatus for gripping groups of cartons. While GOLDBERG ET AL is not specifically directed to gripping groups of cartons, it does meet all the structural requirements of the claim. MPEP 2115 address this issue and is quoted here for your convenience:

MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT
APPARATUS CLAIMS

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In In re Young, a claim to a machine for making concrete beams included a limitation to the concrete reinforced members made by the machine as well as the structural elements of the machine itself. The court held that the inclusion of the article formed within the body of the claim did not, without more, make the claim patentable.

In In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited "[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in

free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface." An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that "the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."

Response to Arguments

9. Applicant's arguments filed 9/23/2003 have been fully considered but they are not persuasive.

10. Applicant asks on page 2 lines 9-15 of his Response about the individual words describing the claim features found in GOLDBERG ET AL (shaft, slide, bearing opening, etc.).

11. However, Applicant is reminded that during examination, the Examiner must make use of the broadest possible interpretation of Applicant's claims. In that light, it is not the terminology that marks the relevance of the prior art, but rather the structure of the prior art invention itself. While GOLDBERG ET AL does not use the same terminology as Applicant for analogous parts, the invention of GOLDBERG ET AL clearly shows a first slide rod (44) and a second slide rod (46). The first slide rod goes through a bearing opening in the second clamp bar and, likewise, the second slide rod goes through a bearing opening in the first clamp bar. Each slide rod is also connected to a side of gripper body (26). The motor (42) causes the first and second slide rods to move the clamp bars toward and away from each other as desired.

In order to describe the above features, the Examiner has read the Specification as well as the Claims and Drawings of the GOLDBERG ET AL reference to determine the function and structure and described it in the terminology favored by Applicant.

Examiner also notes that in the description of GOLDBERG ET AL in paragraph 5 above, the words "slide rod" have been used to reflect Applicant's own terminology. The same features were labeled as "shafts" in a previous Office Action, but the structure is exactly the same – the

terminology is simply changed to enable Applicant to more clearly distinguish the relevance of the prior art structure.

12. Applicant states on page 2 lines 16-17 of his Response that “The examiner has not referred to either item [shaft or bearing opening] by number . His explanation has no point of reference to 515 [GOLDBERG ET AL] at all.”

13. However, the explanation in paragraph 5 above does point out that the slide rods of GOLDBERG ET AL are shown in Fig. 1 as (44, 46). The bearing openings in the clamp bars of GOLDBERG ET AL are shown in Figure 1 by means of showing the slide rods “disappearing” into the clamp bars and “reappearing” on the other side of the clamp bars. In fact, the slide rods go through an opening in the clamp bars. The openings are not numbered in the figures of GOLDBERG ET AL, but they are clearly there, as shown by the drawings and also since the Specification describes how they work.

14. Applicant states on page 2 lines 22-23 of his Response that “Where are the bearing openings mentioned by the Examiner? They are none. They are a fiction.”

15. However, the openings are shown in Fig. 1 of GOLDBERG ET AL, as explained in paragraph 15 above. Examiner also notes that if there were no openings in the clamp bars (12, 20) of GOLDBERG ET AL, the slide rods (44, 46) would not be able to go through them, rotate, and move the clamp bars toward and away from each other, as described in the Detailed Description of GOLDBERG ET AL.

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16. Applicant states on page 3 lines 3-7 of his Response that “The Examiner suggests that 515 [GOLDBERG ET AL] ‘clearly describes the motor etc’ Quite plainly the description is anything but clear. There is no illustration of any structure which might transmit movement from the motor 42 to the worm gears 44 and 46..”

17. However, while the Drawings of GOLDBERG ET AL do not show the connection, column 2 lines 63-66 clearly describe such a connection. They refer to the shafts as “worm gears”, but that does not change their structure or function as described.

18. Applicant states on page 3 lines 10-16 of his Response that “The correctly described ‘worm gears 44 and 46’, (incorrectly referred to by the Examiner as “shafts”) cannot move the two members 12 and 14 towards each other.” ... “If theses WORM GEARS 44 and 46 ‘turn’ they will move both member 12 and 14 in the same direction.”

19. However, while GOLDBERG ET AL does not specifically state that the worm gears (slide rods) are oppositely threaded, Examiner maintains that one of ordinary skill in the art at the time the invention was made could understand this from the Specification’s Detailed Description of the structure as well as its described function. If both the worm gears (slide rods) were threaded the same way, then the invention of GOLDBERG ET AL would not work as described.

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20. Applicant states on page 6 of his Response that he has not received copies of the references cited in the previous Office Action.

21. Examiner will enclose herewith a new List of References Cited and copies of those references, along with any newly cited references.

Reference Citations

22. The following prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

- SCHMITZ discloses a gripping apparatus with a shaft placed through an opening in each of two clamping members.
- HINTZE discloses a gripping apparatus with a shaft placed through an opening in each of two clamping members.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

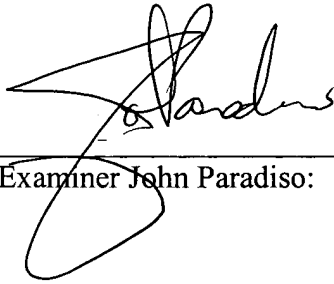
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (703) 308-2825



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700

December 11, 2003

Additional Phone Numbers:

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